

REMARKS/ARGUMENTS

Claims 1-4 are pending in the present Application for further consideration. New independent Claim 5 is being added by this Amendment. No claim is amended in this Response. Favorable consideration and prompt allowance of all of the pending claims in view of the following remarks is respectfully requested.

Applicant respectfully responds to the Office Action dated February 8, 2007 as follows:

In the Office Action, the Examiner rejected Claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 3,976,078 to Toriello ("the Toriello Patent"). Applicant respectfully traverses all of the Examiner's rejections.

The Toriello Patent Teaches Away From the Claimed Invention

In the Examiner's view, Toriello discloses an acupuncture needle comprising a handle having a length, and a needle having an exposed length. The Examiner concedes that Toriello does not disclose the exact claimed lengths and widths of the handle and needle, and ratios thereof. The Examiner contends that Toriello teaches the needle unit is adapted to be made in different lengths so that it can be used to treat all body portions. Accordingly, says the Examiner, it would have been obvious to a person of ordinary skill in the art to modify the sizes of the needle unit disclosed in Toriello to accommodate the patient and procedure.

Toriello teaches, in a preferred embodiment, a needle having a diameter of 0.014 inches (0.356 mm.), a handle member having an outer diameter of 0.050 inches (1.270 mm.) and a length of 1.250 inches (31.750 mm.), and an exposed needle length varying

in length from 2.25 to 4.25 inches (57.150-107.950 mm.). (Col. 2, ll. 29-37). These dimensions result in a ratio of needle to handle of 1.8-3.4 and a ratio of handle plus needle to handle of 2.8-4.4. Both ratios fall outside the ratios claimed in Application Claim 1. Further, the preferred handle length and exposed needle length of the Toriello Patent are different from the lengths claimed in Application Claim 2. Further still, the Toriello Patent discloses a preferred needle width of 0.356 mm., which is not a decimal harmonic of the Golden Ratio as claimed in Application Claim 3. The foregoing preferred dimensions of the Toriello Patent are also distinct from the ratios claimed in Application Claim 4.

Further, as set forth in the accompanying Declaration Under 37 C.F.R. § 1.132 by inventor Jack Pessin, one of skill in the art would choose a needle depending on the style of acupuncture he or she practices. The needle disclosed in Toriello is vastly longer than the present invention and better suited for Chinese-style acupuncture, which involves deep insertions into the skin. The needle of the present invention is shorter than that of Toriello and would be undesirable to a Chinese-style practitioner. Accordingly, it would not have been obvious to one of skill in the art to construct the device disclosed in Toriello using the dimensions and ratios of the present invention since the two needles are for use in two disparate styles of acupuncture.

Accordingly, it is respectfully submitted that the preferred dimensions of the Toriello Patent teach away from the invention claimed in Application Claims 1-4 and cannot therefore be a basis for a rejection under 35 U.S.C. § 103.

The Claimed Ratios are Not Result-Effective Variables

The Examiner further contends that Claims 1-4 would have been obvious to one of ordinary skill in the art because discovering an optimum value of a result effective variable involves only routine skill in the art. Before a determination of routine experimentation can be made, “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result.” MPEP 2144.05(II)(B). According to the Examiner, the Toriello Patent indicates that “[t]he needle unit is adapted to be made in different lengths” (Col. 1, ll. 10-16) (emphasis added). Claims 1-4 of the instant Application address the length of the handle, exposed needle length, ratio of combined handle length and exposed needle length to handle length, ratio of handle to exposed needle length, handle width, and needle width. The length of the full needle unit is not itself a variable in any claim of the instant Application. The Examiner has not established that any of the claimed ratios and lengths is a “result-effective variable.” Accordingly, the Applicant’s discovery of certain optimum and critical ratios does not involve only routine skill in the art and the Toriello Patent cannot be a basis for rejection on this ground. *In re Boesch*, 617 F.2d 272 (C.C.P.A. 1980). The Examiner has not cited any other art that suggests that any particular ratio among various measurements of an acupuncture needle achieve a recognized result.

The Claimed Ratios are Critical

The Examiner states that the invention claimed in the instant application amounts to “discovering an optimum value.” However, the Examiner overlooks the criticality of

the ratios and dimensions in the claimed invention. *In re Waymouth*, 499 F.2d 1273, 1276 (C.C.P.A. 1974).

The Specification for the instant Application does not describe the claimed ratios as merely preferred, but critical to the novelty of an acupuncture needle in harmony with the Golden Ratio of approximately 1.618. This harmony with the Golden Ratio is described as being within 4/100th of a millimeter. [0008]. Such close tolerances to the Golden Ratio are essential to the heretofore unknown benefits of an acupuncture needle in harmony with the Golden Ratio, which includes the expectation and the perception of certain harmonic energy-related benefits. [0019].

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In view of the foregoing remarks, it is respectfully requested that the Examiner's rejection of Claims 1-4 as unpatentable over the Toriello Patent be withdrawn and that a timely Notice of Allowance with respect to all of the pending claims be issued in this case. If the Examiner believes that a telephone discussion would be helpful to expedite prosecution, he may call the undersigned attorney at any convenient time.

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A check for \$510.00 is enclosed for the fee for a three month extension of time for a small entity. No additional fees or extensions of time are believed to be due in connection with the filing of this Response. However, authorization is hereby given to charge Deposit Account No. 01-1785 for any deficiency in fees necessary to preserve the pendency of the subject Application, or to credit the same in case of overpayment.

Respectfully submitted,

Appl. No. 10/685,023
Response dated August 8, 2007
Reply to Office Action of Feb. 8, 2007

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Dated: New York, New York
August 8, 2007

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